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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,110	02/13/2006	Achim Adam	710100-22	5504
<div>7590 01/23/2008</div> <div>Robert L Stearns Dickinson Wright 38525 Woodward Avenue Bloomfield Hills, MI 48304-2970</div>				
			EXAMINER ZIMMERMAN, JOHN J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,110

Applicant(s)

ADAM ET AL.

Examiner

John J. Zimmerman

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 7, 2008 (RCE papers).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

THIRD OFFICE ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2008 has been entered.

Amendments

2. The "AMENDMENT" received January 7, 2008 has been entered. Claims 1-8 are pending in this application.

Double Patenting

3. The terminal disclaimer received November 30, 2007 has overcome the provisional nonstatutory obviousness-type double patenting over the claims of copending U.S. Patent Application No. 10/568,109 in view of Kawachi (U.S. 2003/048961).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huhn (U.S. 2001/0016267).

6. Huhn discloses a bearing having a backing layer, a lead-bronze bearing layer, a nickel intermediate layer, a further nickel-tin layer and an overlay (e.g. see claim 1). The backing layer can be steel (e.g. see paragraph [0037]). The first nickel intermediate layer has a thickness of between 1 to 4 μm (e.g. see paragraph [0030]) and the nickel-tin second intermediate layer has a thickness of between 2 and 7 μm (e.g. see paragraph [0029]) and the overlay can have a thickness of 5 to 25 μm (e.g. see paragraph [0028])). The bearing alloy can be copper-aluminum, copper-tin, copper-tin-lead, etc. . . (e.g. see paragraph [0030]). The bearing is exposed to elevated temperatures that would inherently cause some interdiffusion between the layers (e.g. see paragraph [0047]). Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103,

jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. The overlay of Huhn is a tin based alloy that contains 5 to 48 % of tin-copper particles (e.g. see paragraphs [0019] and [0023]). While the overall copper range in the tin based overlay of Huhn may not be coextensive with the claimed range, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549. Likewise, while the thickness range of the overlay of Huhn may not be coextensive with all the claimed overlay thickness ranges, the ranges overlap and it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to practice the thickness ranges of Huhn over his entire disclosed range. In addition, while the thickness range of the nickel first intermediate layer of Huhn may be 1 to 4 μm and the applicant claims a thickness range of "greater than 4 μm ", the values of "4 μm " and "greater than 4 μm " are so close that *prima facie* one of ordinary skill in the art would not expect them to be patentably distinct. A review of the applicant's disclosure shows no factual data patentably distinguishing a nickel layer thickness value of "4 μm " from "greater than 4 μm ". Regarding the limitation that the intermediate layer be a single layer of nickel in direct contact with the bearing metal and the overlay (e.g. claim 1, lines 6-7), it is noted that

while Huhn uses a combination of an intermediate nickel layer and a second intermediate nickel-tin layer instead of a single nickel layer, Huhn clearly discloses that the use of a single nickel intermediate diffusion barrier layer between the bearing metal and the overlay of a multilayer bearing is a conventional bearing arrangement in the prior art (e.g. see paragraph [0008]).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a single nickel intermediate layer between a bearing metal and an overlayer because this simply yields the prior arrangement before the use of dual intermediate layers as disclosed by Huhn. There is no patentable distinction in regressing to the prior art single nickel intermediate layer embodiment and the elimination of the nickel-tin second intermediate layer of Huhn and its function would have been obvious to one of ordinary skill in the art if an improvement in performance does not justify the economics of including the second intermediate layer. See MPEP 2144.01(II). See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

Response to Arguments

7. Applicant's arguments filed May 31, 2007 have been fully considered but they are not persuasive with regards to the remaining rejections.

8. Regarding the rejection under 35 U.S.C. 103(a) as being unpatentable over Huhn (U.S. 2001/0016267), applicant has added the limitation that the intermediate layer be a single layer of nickel in direct contact with the bearing metal and the overlay (e.g. claim 1, lines 6-7). It is noted, however, that while Huhn uses a combination of an intermediate nickel layer and a second intermediate nickel-tin layer instead of a single nickel layer, Huhn clearly discloses that the use

of a single nickel intermediate diffusion barrier layer between the bearing metal and the overlay of a multilayer bearing is a conventional bearing arrangement in the prior art (e.g. see paragraph [0008]). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a single nickel intermediate layer between a bearing metal and an overlayer because this simply yields the prior arrangement before the improvement realized by the use of dual intermediate layers as disclosed by Huhn. There is no patentable distinction in simply regressing to the prior art single nickel intermediate layer embodiment with the expectation of simply not taking advantage of the improvements that would be expected to be conferred by the second intermediate layer. The elimination of the nickel-tin second intermediate layer of Huhn and its function would have been obvious to one of ordinary skill in the art if an improvement in performance for a particular bearing would not be expected to justify the economics of including the second intermediate layer and its advantages. See MPEP 2144.01(II). See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Rena Dye can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/568,110
Art Unit: 1794

Page 7

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
January 17, 2008